

THIS DEPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 19, 00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Times Mirror Magazines, Inc.

Serial No. 75/467,009

Avis Frazier-Thomas for Times Mirror Magazines, Inc.

Hannah M. Fisher, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Hanak, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Times Mirror Magazine, Inc. has filed an application to register the mark "THE SPORTING NEWS MID-SEASON FANTASY BASEBALL CHALLENGE" for services identified as "role playing games, namely, providing sports fans with a format wherein they are able to draft individual professional players from the field of baseball and compete with these selected individuals in fictitious playoff and championship games."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 75/467,009, filed on April 13, 1998, which alleges dates of first use of January 31, 1993. Registration is sought pursuant to the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

applicant's mark, when applied to its role playing game services, so resembles the mark "FANTASY BASEBALL," which is registered for "entertainment services--namely, conducting a mock baseball game,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

Preliminarily, we note by way of background that the Examining Attorney in the initial Office action imposed the requirement that applicant enter a disclaimer of the terms "SPORTING" and "MID-SEASON FANTASY BASEBALL CHALLENGE." As support for her position, the Examining Attorney attached copies of excerpts from a "sports database" showing that "the wording 'fantasy baseball' is used in a generic manner by third parties." Such extracts, from several newspaper sources, contain general references to "fantasy baseball" and "fantasy baseball leagues." Applicant, in response to the disclaimer requirement and the evidence furnished in support thereof, amended its application to one seeking registration under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), and submitted a declaration in support of its claim of acquired distinctiveness based upon substantially exclusive and continuous use of its mark since January 31, 1993. The Examining Attorney accepted applicant's evidence of acquired distinctiveness and withdrew the disclaimer requirement.

² Reg. No. 1,335,993, issued on May 14, 1985, which sets forth dates of first use of June 11, 1981; combined affidavit §§8 and 15. The word "BASEBALL" is disclaimed.

Additionally, in the initial Office action, the Examining Attorney refused registration on the ground of likelihood of confusion. It is that refusal which constitutes the sole issue now before us. The Examining Attorney maintains that applicant has "improperly attempted to appropriate registrant's mark." She argues that the general rule that a "likelihood of confusion is not avoided between otherwise confusingly similar marks by merely adding a house mark or matter that is descriptive or suggestive" of the goods or services³ is controlling here. In her view, applicant has simply added its house mark "THE SPORTING NEWS" and the descriptive terms "MID-SEASON" and "CHALLENGE" to registrant's mark "FANTASY BASEBALL." Any claim of fame by applicant for its house mark, the Examining Attorney indicated in her final refusal, does not change the applicability of the general rule.

As for the respective services, she points out that the marks of both applicant and registrant are being used on games involving the same sport, namely, baseball and are therefore likely to be of interest to the same class of purchasers, namely, baseball fans. Applicant, we note, does not contend otherwise.

³ Although, at times, both applicant and the Examining Attorney treat the entertainment activities provided by applicant under its mark as goods (i.e., games) rather than services (even though the specimens of use, which constitute advertising rather than tags or labels, are plainly acceptable only as evidence of service mark use instead of trademark use), the Examining Attorney is correct that the result in this case is the same irrespective of whether the entertainment activities provided by applicant are considered goods or services. As the Examining Attorney points out, both applicant and registrant are offering "mock/fictitious games involving the same sport, baseball. Because of this common focus, the endeavors of both parties are likely to appeal to the same group of consumers, baseball fans."

Applicant asserts, instead, that in addition to the general rule relied upon by the Examining Attorney, consideration must be given to the exceptions, as acknowledged by the Examining Attorney, which have been made with respect thereto. Under such exceptions, confusion will not be found likely if (1) the respective marks in their entireties convey significantly different commercial impressions and/or (2) the matter common to such marks is not likely to be perceived by purchasers as distinguishing source due to its mere descriptiveness or the commonness of its use. Applicant maintains that both of these exceptions are applicable here.

Specifically, applicant argues that its mark "THE SPORTING NEWS MID-SEASON FANTASY BASEBALL CHALLENGE" in its entirety creates a distinct commercial impression from that of the registrant's mark "FANTASY BASEBALL" in view of the additional presence in applicant's mark of its previously registered mark "THE SPORTING NEWS"⁴ and of the terms "MID-SEASON" and "CHALLENGE." Applicant further asserts that the term "FANTASY BASEBALL" is highly descriptive, as evidenced by the excerpts made of record by the Examining Attorney, and thus registrant's mark is so limited in service mark significance that the addition of both applicant's registered mark "THE SPORTING NEWS" and the terms "MID-SEASON" and "CHALLENGE" serve to negate any likelihood of confusion.

⁴ In its application, applicant has claimed ownership of five registrations for the mark "THE SPORTING NEWS" and variations thereof. Each registration contains a claim of acquired distinctiveness under Section 2(f) of the statute as to the phrase "THE SPORTING NEWS."

While it is indeed a general rule that the addition of a house mark or a trade name to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion, an exception has been made in those cases where there are some recognizable differences between the assertedly conflicting marks, so that the addition to one of a house mark or trade name or other such matter may be sufficient to render the marks as a whole distinguishable and thus avoid confusion. See, e.g., In re Avnet, Inc., 195 USPQ 185, 187 (TTAB 1977) and cases cited therein.

Here, there are obvious differences in appearance and sound between registrant's mark "FANTASY BASEBALL" and the service (or product) mark portion "MID-SEASON FANTASY BASEBALL CHALLENGE" of applicant's mark "THE SPORTING NEWS MID-SEASON FANTASY BASEBALL CHALLENGE." The addition of the term "MID-SEASON" in applicant's mark plainly indicates the time in the baseball season during which applicant's role playing games commence, while the presence of the word "CHALLENGE" in such mark clearly refers to the competitive nature of applicant's role playing games, i.e., that sports fans are provided with a format in which they can compete with others after selecting their team of professional baseball players. Registrant's mark "FANTASY BASEBALL" contains no such temporal or competitive indications, nor does the recitation of its services as "entertainment services--namely, conducting a mock baseball game," although inclusive of applicant's role playing games, confer an inference of any such temporal or competitive nature.

Furthermore, we cannot ignore the fact that the term "FANTASY BASEBALL" has been demonstrated, by the very evidence made of record by the Examining Attorney, to be descriptive, at least in certain contexts. In addition, applicant has amended its application to one seeking registration under Section 2(f) and submitted evidence of acquired distinctiveness to overcome the requirement for a disclaimer, inter alia, of the term "FANTASY BASEBALL," as used in its mark.⁵

It is true, of course, that we cannot entertain any arguments that the cited mark "FANTASY BASEBALL" is merely descriptive, as used by registrant in connection with its entertainment services--namely, conducting a mock baseball game, inasmuch as such would constitute an impermissible collateral attack on the validity of the registration. See, e.g., *In re C. F. Hathaway Co.*, 190 USPQ 343, 345 (TTAB 1976) and cases cited therein. Consequently, we cannot agree with applicant's reliance upon *In re S. D. Fabrics, Inc.*, 223 USPQ 54, 56 (TTAB 1984), in which both product marks had been adjudged or acknowledged to be merely descriptive.

Nevertheless, we can and do view the evidence of record and applicant's acquiescence with the disclaimer requirement by amending its application to one seeking registration under Section 2(f) as indications of the highly suggestive nature of

⁵ The Examining Attorney, citing TMEP Section 1212.02(e), notes in her brief that applicant, after amendment of its application to Section 2(f), "has not disclaimed 'fantasy baseball[,]' which should be done for generic wording." Applicant, however, was never required to enter such a disclaimer and no inferences whatsoever can therefore be drawn from its asserted failure to do so.

the term "FANTASY BASEBALL" when used in connection with any type of sports games involving baseball. In view of this inherent suggestiveness, coupled with the specific differences in sound, appearance and connotation between registrant's mark "FANTASY BASEBALL" and the service (or product) mark portion "MID-SEASON FANTASY BASEBALL CHALLENGE" of applicant's mark "THE SPORTING NEWS MID-SEASON FANTASY BASEBALL CHALLENGE," we find the addition of the house mark "THE SPORTING NEWS" serves to render the respective marks as a whole distinguishable and thus precludes a likelihood of confusion. The cumulative dissimilarities in the marks at issue, despite their use on games which simulate baseball, are sufficient to avoid confusion as to source or sponsorship. See, e.g., MarCon Ltd. v. Avon Products Inc., 4 USPQ2d 1474, 1476 (TTAB 1987) [addition of house mark "AVON" to suggestive term "SILKEN" is sufficient to distinguish mark "AVON SILKEN SOAP" for liquid body soap from mark "SILK" for variety of cosmetic and beauty care products including bubble bath, hair shampoo, and face and body creams and lotions].

Decision: The refusal to register under Section 2(d) is reversed.

E. W. Hanak

T. J. Quinn

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board